#9
4-11-03

PATENT
Customer No. 22,852
Attorney Docket No. 03063.0398-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Hao CHEN et al.	Group Art Unit: 1774
Application No.: 09/930,705	Examiner: M. Dixon
Filed: June 29, 2001	
For: SURFACE COVERINGS CONTAINING ALUMINUM OXIDE	

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE UNDER 37 C.F.R. §1.111

In response to the Office Action of October 4, 2002, the period for response having been extended three months to April 4, 2003, by the petition and fee filed herewith, Applicants request reconsideration in view of the following remarks.

REMARKS

I. Status of the Claims

Claims 1-5, 7, and 9-59 are currently pending, although the Examiner has withdrawn from consideration claims 14-29 as being drawn to a non-elected invention. No claim has been amended by the response.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Restriction Requirement

The Examiner has maintained and made final the restriction between

Group I, claims 1-13 and 31-53, drawn to a resilient surface covering; and

Group II, claims 14-29 and 54-59, drawn to a method to improve wear resistance.

Applicants maintain their traversal of this restriction requirement for the reasons of record, as well as for the following reasons. Because all of the essential elements of the resilient surface covering claims of Group I are included within the method of the claims of Group II, a proper search for the subject matter of Group I would necessarily encompass the search for the subject matter of Group II.

In addition, the rejection of the Group I claims under 35 U.S.C. 103 based on U.S. Patent No. 5,670,237 to Shultz et al. is improper (the Shultz patent is not prior art to the pending claims for the reasons detailed below), and this rejection should be withdrawn.

In accordance with MPEP 821.04, therefore, the Examiner should rejoin the non-elected method claims, which include the elements of the allowed product. (See MPEP 821.04, which states, in relevant part, "[I]f applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined"). For these reasons, as well as those described below, Applicants respectfully request that the restriction requirement be removed and all the pending claims be allowed.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 1-5, 7, 9-13, and 30-55 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,670,237 to Shultz et al. ("Shultz"). In view of changes to 35 U.S.C. §103(c), however, the Shultz patent is not prior art to the pending claims. *See*, MPEP 706.02(l)(3). References that would ordinarily be prior art under §102(e)[1] shall not preclude the patentability of an invention, if: (1) the invention was developed by another person; and (2) was commonly owned or subject to an obligation of assignment to the same entity.

In the present application, Chen and Rufus are listed as co-inventors, whereas Shultz and Crispin are the co-inventors of U.S. Patent No. 5,670,237 to Shultz. Thus, the claimed invention was developed by "another person."

The common assignment of both the Shultz patent and the present application to Mannington satisfies the second requirement. Copies of the recordation cover sheets evidencing the obligation of assignment of the present application and the Shultz patent to the same entity, Mannington, are enclosed herewith. Thus, both requirements for triggering the provision of 103(c) are met.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

[1] The Shultz patent is prior art under § 102(e) because Applicants rightfully claimed the benefit of priority to provisional application 60/038,879, filed February 20, 1997, which is before the September 23, 1997 issue date for the Shultz patent. A copy of the declaration filed with the parent application (08/956,022, now US Patent No. 6,291,078B1) is attached herewith. The declaration expressly claims the benefit of priority to provisional application 60/038,879, filed February 20, 1997. See, e.g., MPEP 201.11 (stating that an application for a patent is entitled to the benefit of the filing date of a provisional application which has at least one common inventor).

Finally, this statutory provision applies to any application filed on or after November 29, 1999, which is clearly met by the present application, which was filed on April 9, 2001.

As the Shultz patent is not prior art to the pending claims, Applicants submit that this rejection is improper and respectfully request that it be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 4, 2003

By: Stephen T. Peterson 26,325 /sp
Louis M. Troilo
Reg. No. 45,284

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com